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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,606	03/19/2004	Peter Cagliari	930024-2008	9555
20/999 7590 07/29/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
MOHANDESI, JILA M				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
07/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,606

Applicant(s)

CAGLIARI ET AL.

Examiner

JILA M. MOHANDESI

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3-9 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chenevert (US 6,499,233) in view of Saillet et al. (US 6,938,362). Chenevert discloses a sports boot for gliding boards such as skates, comprising a first part in a first material (footbed 58, see column 7, lines 7-17) and a second part superposed on said first part and a second material (skin assembly 60 preferably made of synthetic fabric or textile material such as nylon, aramid textile used with or without a thermoplastic sheet backing), and reinforcement means (thermoplastic shell 20, with sole 32 and thinned wall portions 38 and 39, see column 5, lines 14-40) wherein the reinforcement means are at least partly formed by at least one frame which is positioned at least partially between said parts wherein said frame is partially covered by said second part, and wherein the first part, second part and reinforcement means are fixed together (inasmuch as applicant has disclosed what is meant by "fixed together" the first part, second part and reinforcement means of Chenevert are construed to be fixed together since they are all held together to form the sports boot). See Figures 4-6 embodiments. Chenevert does not appear to disclose the reinforcement means formed by at least one frame in synthetic material internally reinforced with mineral or synthetic fibers positioned at least partially between said parts and the mineral or synthetic fibers being embedded in a matrix. Saillet discloses a

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reinforcement for a boot, wherein one of the layers of said sandwich structure is made of a composite material based on woven or nonwoven fibers included in a matrix, wherein: the fibers comprise a member selected from the group consisting of the following materials: carbon fibers, glass fibers, metallic fibers, natural and synthetic textile fibers, and mixtures of such materials; the matrix comprises a member selected from the group consisting of the following materials: epoxy, polyester, and phenolic resins; thermoplastics, including polyamides, polyurethanes, polyolefins, and mixtures of such materials; and the core of the sandwich structure comprises a member selected from the group consisting of the following materials: a synthetic foam, wood and a honeycomb structure, to improve the torsional stiffness, efficiency, durability, lightness, cost, foot protection, and industrial workability. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the thermoplastic reinforcement means of Chenevert from a thermoplastic matrix as taught by Saillet to improve the torsional stiffness, efficiency, durability, lightness, cost, foot protection, and industrial workability and yield only predictable results. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill."

Claim 16, is a product-by-process claim, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product

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was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Allowable Subject Matter

3. Claims 2 and 10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed 04/16/2008 have been fully considered but they are not persuasive. Inasmuch as applicant has disclosed what is meant by "fixed together" the first part, second part and reinforcement means of Chenevert are construed to be fixed together since they are all held together to form the sports boot.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
July 25, 2008